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PATENT
Docket No.: 45751USA6C.012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

JOSEPH P. KRONZER ET AL.

Serial No.: 08/661,834

Filed: June 11, 1996

For: FIBROUS FILTRATION FACE MASK



Group Art Unit: 3761

Examiner: Aaron J. Lewis

#36 / Reply Brief
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REPLY BRIEF

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

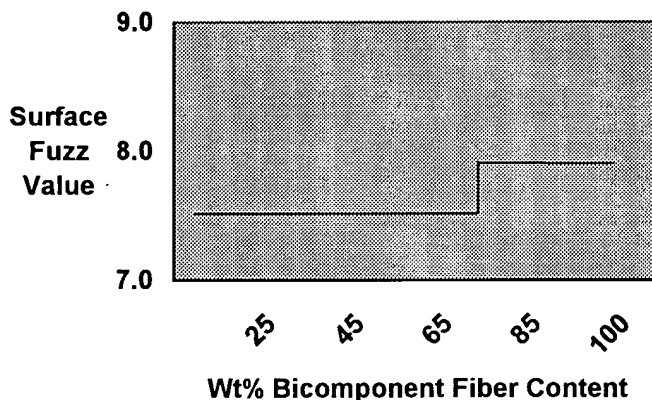
This Reply Brief is submitted in response to the additional points of argument made by the Examiner on pages 7 and 8 of the Examiner's Answer mailed December 19, 2000.

The Examiner asserts that it is legally impermissible to further limit a "broad range limitation" within the same claim. Because any attempt to do so would result in confusion and render unclear the metes and bounds of the claimed subject matter. No authority has been cited to support this position.¹

As the claims are presently worded, the nonwoven fibrous layer has a surface fuzz value of not less than 7.5 under all instances regardless of bicomponent fiber content. If the bicomponent fiber content is 85 weight percent or greater, however, the surface fuzz value then exceeds 8.0. In other words, there is a stair-step to the surface fuzz value. In the first step, the value is not less than 7.5. In the second step, the surface fuzz value exceeds 8.0. The second step, however, is

¹ The Examiner did cite case law in the Office Action mailed May 23, 2000, but none of the cases cited by the Examiner support the Examiner's position. Indeed, the lead case cited by the Examiner, namely, *Ex parte Wu* involved the question of whether the language "optionally" would render a claim indefinite. In *Wu*, the Board held that the claims are not "indefinite as result of [using] the claimed optional component." *Ex parte Wu*, like the other cases cited by the Examiner, also discuss use of the language "such as" in a claim. The claims presented for appeal in this case, however, do not use "such as" language, and therefore the cases cited by the Examiner are not pertinent.

only reached if the bicomponent fiber content is 85 weight percent or greater. The following chart shows what is being claimed:



As the above chart shows, there is nothing vague or indefinite about the subject matter that is presented in claim 25. The area above the solid stair-step line is subject matter covered by the claim. Applicants should be permitted to further refine the meaning of a more generically described term within the same claim as long as the generic language and the further refinements can be reasonably understood by a person of ordinary skill in the art to which the invention pertains. Under the wording of the present claim, applicants see no reason why a person of ordinary skill cannot understand where the metes and bounds of the claimed subject matter reside.

In regard to the language "and optionally staple fibers", the Examiner asserts that "it is not clear whether the staple fibers are intended to substituted for either the thermally bonding fibers or the bicomponent fibers or whether appellants intend that the staple fibers are to be added to the thermally bonded fibers and bicomponent fibers." Appellants believe that the issue raised by the Examiner is not an issue at all. The claim requires at least about 40 weight percent thermally bonding fibers and at least about 10 weight percent bicomponent fibers. The nonwoven layer may also include staple fibers. It does not matter whether the staple fibers are substitutes for or are used in addition to the other fibers. All that matters is whether the nonwoven fibrous layer includes at least about 40 weight percent thermally bonding fibers and at least about 10 weight percent bicomponent fibers. Thus, the Examiner's reason for rejecting the claim is not meaningful.

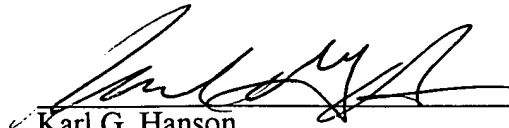
In regard to the prior art rejection, the Examiner indicates that it does not matter whether Dyrud fails to present an enabling disclosure because the present claims do not "define a method of cold molding". Appellants assert that this position is off target since Appellants are not distinguishing their invention from Dyrud on the basis of how the product is made. Instead Appellants are arguing that Dyrud fails to teach how to make the invention so as to satisfy the first paragraph of 35 U.S.C. § 112. As the Board is aware, the issue regarding enablement is whether the reference relied on provides a teaching that would allow a person of ordinary skill to make and use the claimed invention. Without such a teaching in the prior art, a rejection cannot be sustained under the terms of 35 U.S.C. § 103.

The presently-claimed invention requires that the surface fuzz value exceed 8.0 for masks that contain nonwoven fibrous layers that have bicomponent fiber in an amount of 85 weight percent or greater. The present record only shows that the highest surface fuzz value achievable using the hot molding method is 8.0. This value is only achievable when 100 percent bicomponent fiber is used. Since Dyrud does not disclose a cold-molding method, it does not teach how to achieve the higher surface fuzz values of the present invention. The Examiner's arguments concerning the need to define a cold molding method in the claims might be pertinent if the present invention was directed to a method of making, but that is not the case here. The present claims are directed to a fibrous filtration face mask that has a certain surface fuzz value. The Dyrud patent does not teach how to make this product. The law requires that the United States Patent and Trademark Office meet its burden of showing that the prior art references teach a way to make the invention being claimed. Because this evidence is not of record in the present application, and therefore the obviousness rejection cannot be sustained.

For the above reasons, applicants submit that the rejections made above should be reversed.

Dated this 1st day of February, 2001.

Respectfully submitted,


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Pursuant to 37 C.F.R. § 1.8 I certify that this correspondence is being deposited on the date indicated below
with the United States Postal Service as First Class Mail in an envelope addressed to:
Assistant Commissioner for Patents, Washington, DC 20231


Karl G. Hanson

Dated: February 1, 2001